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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/579,383	05/26/00	VINETZ J	026.00101

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EXAMINER	
BASKAR, P	
ART UNIT	PAPER NUMBER
1645	4

DATE MAILED: 09/28/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary	Application No. 09/579,383	Applicant(s) VINETZ, JOSEPH M.	
	Examiner Padmavathi v Baskar	Art Unit 1645	

-- The MAILING DATE of this communication appears on th cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) 1-45 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) 1-45 are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

RESTRICTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I Claims 1-12, 23 and 24 drawn to DNA, vector and host cell classified in class 536, subclass 23.7. Further election of invention (i.e., SEQ.ID.NO is required).

II. Claims 27-30 and 37 drawn to polypeptide classified in class 530, subclass 350. Further election of invention (i.e., SEQ.ID.NO is required).

III Claims 31-33 and 36 drawn to an antibody and method of making an antibody classified in class 530, 424, subclass 388.6, 184.1 respectively Further election of invention (antibody that binds to SEQ.ID.NO is required).

IV Claims 13-18 drawn to a method of decreasing or increasing the expression of Plasmodium chitinase classified in class 424, subclass 265.1 Further election of invention (i.e., SEQ.ID.NO is required).

V Claims 38, 40-45 drawn to a method for the prevention of infection. classified in class 424, 514, subclass 184.1, 44 respectively. Further election of invention (i.e., SEQ.ID.NO is required).

VI Claims 25-26 drawn to a method of detecting the Plasmodium chitinase in a sample using nucleic acid classified in class 435, subclass 6. Further election of invention (i.e., SEQ.ID.NO is required).

VII Claims 34-35 drawn to a method of detecting the Plasmodium chitinase in a sample using protein antigen and antibody classified in class 435, subclass 7.22. Further election of invention (i.e., SEQ.ID.NO is required).

VIII Claims 19-22 and 39 drawn to a method of screening a substance and obtaining DNA encoding Plasmodium classified in class 435, subclass 69.1. Further

election of species required Further election of invention (i.e., SEQ.ID.NO is required).

2. The inventions are distinct, each from the other because of the following reasons:

Group I is directed to DNA, which consists of nucleic acids. Groups II is directed polypeptides, which are made of amino acids, Invention III is drawn to an antibody and is distinct from Inventions I-II since it has an inherent affinity, avidity, and specificity that DNA or a simple protein is not capable of expressing. These products are different to each other structurally, biochemically and functionally.

Groups IV-VIII are different methods utilizing different products with different structure and biological properties. Inventions VI-VIII are drawn to different methods of detecting and screening Plasmodium infections utilizing different biological reagents such as nucleic acids, proteins, and antibodies. Inventions IV-V are drawn to methods for decreasing or increasing the expression of Plasmodium and their use in preventing Plasmodium infection utilizing different products namely proteins, nucleic acids and antibodies. Thus Inventions IV, V, VI, VII and VIII are different methods using different biological reagents, different method steps which result in different outcome.

3. Invention II is related to inventions IV, V, and VII as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the protein of Group II can be used in immunoaffinity chromatography methods for purifying antibodies and need not be used in the inventions IV, V, and VII.

4. Invention I is related to inventions IV, V and VI as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the nucleic acid of Group I can be used to make probes for using it in vitro hybridization and need not be used in the inventions IV, V and VI

5. Invention III is related to inventions IV, V and VIII as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the antibody of Group III can be used in immunoaffinity chromatography for purifying antigens and need not be used in the inventions IV V and VIII

Distinct Inventions

6. Although there are no provisions under the section for "Relation of Inventions" in MPEP 806.05 for inventive groups that are directed to different products; restriction is deemed proper because these products appear to constitute patentably distinct inventions for the following reasons.

Groups I- VIII contain claims (1-45) reciting a plurality of disclosed patentably distinct inventions with distinct SEQ.ID.NOS. If applicant elects one SEQ.ID.NO from any group, associated sequences, which share the common structure or overlap the sequence of that SEQ.ID.NO (for example epitope or oligonucleotide) will be examined. Applicant is advised to elect one SEQ.ID.NO and identify the associated sequence, which share the common structure

or overlap the sequence of that SEQ.ID.NO with specific amino acid or nucleic acid or antibody. Applicant is required under 35 U.S.C. 121 to elect a single disclosed SEQ.ID.NO and associated sequence which share the common structure or overlap the sequence of that SEQ.ID.NO with specific amino acid or nucleic acid or antibody.

If applicant elects any one invention from any group, then applicant is advised to elect either polypeptide or polynucleotide or antibodies and specify a single disclosed SEQ.ID.NO.

7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their separate classification and their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

8. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

9. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Padmavathi v Baskar whose telephone number is (703) 308-8886. The examiner can normally be reached on M-F (6:30A.M-4: 00 P.M.) First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith can be reached on (703) 308-3909. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

P. Baskar Ph.D.
9/27/01